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CALFEE HALTER & GRISWOLD, LLP  
800 SUPERIOR AVENUE  
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CLEVELAND OH 44114

**COPY MAILED**

**FEB 08 2006**

**OFFICE OF PETITIONS**

In re Application of  
Montano et al.  
Application No. 09/972,032  
Filed: October 5, 2001  
Attorney Docket No. 27708-04003

DECISION ON PETITION

This is a decision on the petition filed on January 25, 2006, to withdraw the holding of abandonment.

The application became abandoned for failure to reply timely to the Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures ("Notice to Comply"), mailed on April 21, 2005, which set a one-month extendable period for reply. In the absence of a timely filed response, the application became abandoned on May 22, 2005. A Notice of Abandonment was mailed on January 4, 2006.

In the present petition, petitioner requests that the Office withdraw the holding of abandonment due to non-receipt of the Notice to Comply of April 21, 2005, remail the Notice and restart the period to reply. The practitioner asserted that a search of the file jacket and docket records indicated that the Notice was not received. In support of the assertion, the practitioner submitted a copy of the docket record for May 19 -24, 2005, where the non-received Notice would have been entered had it been received and docketed.

A review of the record indicates no irregularity in the mailing of the Notice to Comply, and in the absence of any irregularity in the mailing, there is a strong presumption that the Notice was properly mailed to the address of record. This presumption may be overcome by a showing that the Notice to Comply was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner, stating that the practitioner did not receive the Office communication and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where

the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.<sup>2</sup> For example, if a three month period for reply was set in the non-received Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the non-received Office action must be submitted as documentary proof of non-receipt of the Office action.

The showing of record is insufficient to warrant withdrawal of the holding of abandonment at this time. The Notice to Comply set a one-month extendable period for reply. Therefore, the practitioner must submit a copy of the docket report showing all replies docketed for one month from the mail date of the Notice to Comply (*i.e.*, from April 21, 2005, up to and including, May 21, 2005) as documentary proof of non-receipt of the Office action. With the present petition, the practitioner only submitted docket records for the period from May 19-24, 2005.

The petition to withdraw the holding of abandonment is **dismissed**.

Copies of the Notice to Comply, a CRF Problem Report, and the Notice of Abandonment accompany this decision for petitioner's convenience.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." Extensions of time are permitted under 37 CFR 1.136(a). In the alternative, petitioner may wish to file a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application.

Further correspondence with respect to this matter should be addressed as follows and **to the attention of Senior Petitions Attorney Christina Tartera Donnell**:

By mail:                      Mail Stop Petition  
                                    Commissioner for Patents  
                                    P.O. Box 1450  
                                    Alexandria, VA 22313-1450

By FAX:                      (571) 273-8300  
                                    Attn: Office of Petitions

By hand:                     Customer Service Window  
                                    Randolph Building  
                                    401 Dulany Street  
                                    Alexandria, VA 22314

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<sup>2</sup> M.P.E.P. § 711.03(c); See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

*Christina Tartera Donnell*

Christina Tartera Donnell  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Notice to Comply, a CRF Problem Report, and the Notice of Abandonment



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UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,032	10/05/2001	Monica Montano	27708/04003	2885

24024 7590 04/21/2005

CALFEE HALTER & GRISWOLD, LLP  
800 SUPERIOR AVENUE  
SUITE 1400  
CLEVELAND, OH 44114

EXAMINER
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YU, MISOOK

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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09/972,032

EXAMINER

Misook Yu

ART UNIT

PAPER

1642

20050419

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner for Patents**

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR §§ 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

APPLICANT IS GIVEN A ONE MONTH EXTENDABLE PERIOD WITHIN WHICH TO COMPLY WITH THE SEQUENCE RULES, 37 CFR §§ 1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR § 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR § 1.136. In no case may an applicant extend the period for response beyond the six month statutory period. Applicant is requested to return a copy of the attached Notice to Comply with the response.

Please direct all replies to the United States Patent and Trademark Office via one (1) of the following:

1. Electronically submitted through EFS-Bio

(<<<http://www.uspto.gov/ebs/efs/downloads/documents.htm>>>, EFS Submission User Manual - ePAVE)

2. Mailed to:

Mail Stop Sequence  
Commissioner for Patents  
P.O. Box 22313-1450  
Alexandria, VA 22313-1450  
Arlington, Virginia 22202

3. Mailed by Federal Express, United Parcel Service or other delivery service to:

U. S. Patent and Trademark Office  
Box Sequence, Room 1B03-Mailroom  
Crystal Plaza Two  
220 20th Street S.

4. Hand Carried directly to the Customer Window at:

U. S. Patent and Trademark Office  
Box Sequence, Customer Window, Lobby, Room 1B03  
Crystal Plaza Two  
220 20th Street S.  
Arlington, Virginia 22202

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Misook Yu whose telephone number is (571) 272-0839. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be emailed to [cynthia.wilder@uspto.gov](mailto:cynthia.wilder@uspto.gov). Since email communications may

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not be secure, it is suggested that information in such request be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on (571) 272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Any questions regarding compliance with the sequence rules requirements specifically should be directed to the departments listed at the bottom of the Notice To Comply.

Any inquiry of a general nature or relating to the status of this application, or requests to supply missing elements from Office communications, should be directed to the Group receptionist whose telephone number is (571) 272-1600.



Misook Yu 4/19/2005

Application No. 09/972,032

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING  
NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
- ☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked-up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☒ 7. Other: SEQ ID NO: 3, and 4 are missing from the Sequence Listing

**Applicant Must Provide:**

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

For PatentIn software help, call (703) 308-6856

**PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR RESPONSE**

## STIC Biotechnology Systems Branch

1FW16

### CRF Problem Report

The Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) experienced a problem when processing the following computer readable form (CRF):

Application Serial Number: 09/972 032A  
Filing Date: 10/5/01  
Date Processed by STIC: 12/20/05

STIC Contact: Mark Spencer: Telephone: 571-272-2510; Fax: 571-273-0221

#### Nature of CRF Problem:

- ☒ (circle one) Damaged or Unreadable (for Unreadable, see attached)  
☐ Blank (no files on CRF) (see attached)  
☐ Empty file (filename present, but no bytes in file) (see attached)  
☐ Wrong file saved to CRF (invention title, docket number, or applicant(s) do not match those in official application) (see attached)  
☐ Not saved in ASCII text  
☐ Sequence Listing was embedded in the file. According to Sequence Rules, submitted file should **only** be the Sequence Listing.  
☐ Did not contain a Sequence Listing. (see attached sample)  
☐ Other:

**PLEASE USE THE CHECKER VERSION 4.3.1 PROGRAM TO REDUCE ERRORS.  
SEE BELOW FOR ADDRESS:**

<http://www.uspto.gov/web/offices/pac/checker/chkrnote.htm>

1. EFS-Bio (<<http://www.uspto.gov/ebc/efs/downloads/documents.htm>> , EFS Submission User Manual - ePAVE)
2. U.S. Postal Service: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
3. Hand Carry, Federal Express, United Parcel Service, or other delivery service (EFFECTIVE 01/14/05):  
U.S. Patent and Trademark Office, Mail Stop Sequence, Customer Window, Randolph Building, 401 Dulany Street,  
Alexandria, VA 22314

Revised 08/30/05



09/972,032A

12/20/2005

A:\>DIR

Volume in drive A has no label

Directory of A:\

File not found

1,457,664 bytes free

A:\>

onscreen message when STIC PC tried  
to read submitted disk



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,032	10/05/2001	Monica Montano	27708/04003	2885
24024	7590	01/04/2006	EXAMINER	
CALFEE HALTER & GRISWOLD, LLP 800 SUPERIOR AVENUE SUITE 1400 CLEVELAND, OH 44114			YU, MISOOK	
			ART UNIT	PAPER NUMBER
			1642	

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notice of Abandonment**

Application No.

09/972,032

Examiner

MISOOK YU, Ph.D.

Applicant(s)

MONTANO ET AL.

Art Unit

1642

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address–

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 21 April 2005.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

Ms. Wendy Frick was notified on 12/27/05 that notice of abandonment would be mailed to applicant.



MISOOK YU, Ph.D.  
Primary Examiner  
Art Unit: 1642

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.